

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS FROHLICH

Appeal No. 1999-1036
Application 08/644,523

ON BRIEF

Before ABRAMS, STAAB, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claims 1, 4-22, 26 and 29-34, which
constitute all of the claims remaining of record in the
application.

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The appellant's invention is directed to a shear reinforcement system for embedding in a slab floor. The subject matter before us on appeal is illustrated by reference to claim 1, which reads as follows:

1. A shear reinforcement system for embedding in a slab floor, said system comprising:

elongate shear reinforcement members positioned transverse to a plane of a slab floor;

at least one securing element fixedly securing said elongate shear reinforcement members;

said at least one securing element extending transverse to said elongate shear reinforcement members and parallel to the plane of the slab floor, wherein said at least one securing element is an elongate rail, having a U-shaped cross-section with sidewalls, receiving a plurality of said elongate shear reinforcement members;

wherein said elongate shear reinforcement members are bolts having a first and a second end and wherein at least said first end has a head;

said heads inserted into said rail and positive-lockingly and non-displaceably secured by said rail by bending wall portions of said sidewalls inwardly behind said heads.

THE REJECTION¹

Claims 1, 4-22, 26 and 29-34 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for

¹Rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 were overcome by an amendment under 37 CFR § 1.116.

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failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejection and the conflicting viewpoints advanced by the examiner and the appellant regarding the rejection, we make reference to the Examiner's Answer (Paper No. 14) and the Appellant's Briefs (Paper Nos. 13 and 15).

OPINION

It is the examiner's position that the claims are indefinite in that it is not clear from the claim language whether they cover a shear reinforcement system or the combination of a shear reinforcement system and a slab floor. As the basis for this rejection, the examiner notes that although the preamble of each of the independent claims states that they are directed to "[a] shear reinforcement system for embedding in a slab floor" (emphasis added), the body of the claims positively recites the slab floor. For example, lines 3 and 4 of claim 1 recite "elongate shear reinforcement members positioned transverse to a plane of a slab floor," and lines 7 and 8 recite "said at least one securing element

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extending transverse to said elongate shear reinforcement members and parallel to the plane of the slab floor" (emphasis added in both instances). We are not persuaded by the arguments presented by the appellant, and find ourselves in agreement with the examiner that the metes and bounds of the claims are not clear. This being the case, we will sustain the rejection. However, it is our view that the claim language can be modified to overcome the rejection, and we will recommend language to accomplish this below.

Insofar as the evaluation of the rejection is concerned, we first point out that because a patentee has the right to exclude others from making, using and selling the invention covered by the patent, the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance, and it is to this that the second paragraph of 35 U.S.C. § 112 is directed. See *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). According to the preamble of each of the independent claims, the invention is directed to a shear

reinforcement system for embedding in a slab floor. However, from our perspective, this is not clearly carried through in the body of the claim, where it is stated that the shear reinforcement members are not merely positionable with respect to a slab floor, as would seem to be the thrust of the "for embedding" phraseology of the preamble, but are positively related to a particular slab floor by being positioned with respect to a plane "of" that slab floor, which suggests that the floor is part of the claimed invention. This interpretation is confirmed by the phrase that appears further on in the claims, in which another element is defined as extending parallel to the plane of "the" slab floor.

The section of the Manual of Patent Examining Procedures (MPEP), and the cases cited by the appellant do not dissuade us from the above conclusion. MPEP Section 2173.02 states that the claims should be analyzed in light of the disclosure, the prior art, and the interpretation that would be given by one of ordinary skill in the art, and goes on to point out that if the scope cannot be determined "with a reasonable degree of certainty," a rejection under the second paragraph of Section 112 is appropriate. We, like the examiner, are of

the view that these claims do not meet the "reasonable degree of certainty" test. Moving on to the cases cited, the portion of **Vaupel** to which the appellant refers on page 4 of the Brief relates to a method step in which the fabric is guided in such a manner as to "allow movement" toward an element, which simply uses the element as a reference point, as distinguished from being moved toward that element, which suggests that the element actually is part of the claimed invention. The situation in **Orthokinetics** is analogous, in that the claim requires that the device be "insertable" and not inserted between the door frame and the seats. We further point out in this regard that in lines 14-15 of claim 16 the appellant has avoided the problem to which this rejection is directed, in that he has recited that the invention further comprises "connectors for fastening said rail to . . . bars of the slab floor" (emphasis added), which relates the claimed structure (the shear reinforcement system) to the unclaimed structure (the slab floor) without giving rise to the uncertainty of whether the claim positively includes the slab floor, as would have been the case if the language had been simply "fastening said rail . . ."

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Pursuant to our authority under 37 CFR §1.196(c), it is our opinion that the standing rejection of the claims can be overcome, and the claims would be allowable, if the following changes were made to each of claims 1, 6, 9 and 16:

In line 3, change "positioned" to --positionable--.

In line 8, insert --positionable-- after "and".

SUMMARY

The rejection is sustained.

Pursuant to 37 CFR § 1.196(c), amendments have been suggested which would overcome the standing rejection under 35 U.S.C. § 112, second paragraph, and would, in the absence of new references or grounds of rejection on the part of the examiner, cause the claims to be allowable.

37 CFR § 1.196(c) provides:

Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to amend in conformity with such statement which shall be binding upon the examiner in the absence of new references or grounds of rejection.

A statement pursuant to 37 CFR § 1.196(c) has been made in this decision. A time period in which appellant may file

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an amendment for the purpose stated in § 1.196(c) is hereby set
to expire TWO MONTHS FROM THE DATE OF THIS DECISION.

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No time period for taking subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(c)

	Neal E. Abrams)	
	Administrative Patent Judge)	
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)	
	Lawrence J. Staab)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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